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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,411	01/02/2001	Eric D. Bergman	0007056-0053/P5278/ARG	3148
26263	7590	07/21/2005	EXAMINER	
SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080			HUYNH, CONG LAC T	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/754,411

Applicant(s)

BERGMAN ET AL.

Examiner

Cong-Lac Huynh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: RCE filed 5/13/05 to the application filed on 1/2/01.
2. Claims 1-24 are pending in the case. Claims 1, 9, 17 are independent claims.
3. The rejections of claims 1-3, 5-11, 13-19, 21-24 under 35 U.S.C. 103(a) as being unpatentable over Sragner have been withdrawn in view of the amendment.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manning (US Pat No. 6,043,826, 3/28/00, filed 9/2/97) in view of Keskar et al. (US Pat No. 6,829,668 B2, 12/7/04, filed 12/28/00).

Regarding independent claim 1, Manning discloses:

- creating an original document on a computer (**col 1, lines 53-65**: the fact that documents are downloaded from the desktop to the palmtop inherently shows that the original documents are created at the desktop computer)
- transferring said original document to a disconnected device, wherein said disconnected device is a portable electronic device capable of performing computations at any location (**col 1, lines 53-65**: downloading documents to the palmtop computer shows transferring the original documents to a portable electronic device)
- modifying said original document on said disconnected device to form a modified document (**col 1, lines 53-65**: using the palmtop computer to modify the documents and files shows that the documents on the palmtop computer are modified)

Manning does not disclose

- returning said modified document to said computer
- determining one or more modification between said original document and said modified document

Keskar discloses:

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- returning said modified document in a handheld device to said computer (**col 7, lines 55-65**: synchronizing the new item created on the handheld device section with the desktop section implies that modified documents with new items are returned to the desktop computer)
- determining one or more modification between said original document and said modified document (**col 7, lines 55-65**: the fact that the various relation agents automatically see the new item and process it shows that one modification, which means the new item, between the original document and the modified document is determined)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Keskar into Manning since Keskar discloses returning the modified document to the desktop computer and determining one modification between the original document and the modified document providing the advantage to incorporate into Manning for easily adding the documents modified in the portable device to the original document in the desktop computer upon a user desire.

Regarding claim 2, which is dependent on claim 1, Manning discloses utilizing change tracking software (col 1, lines 53-65: modifying documents is performed implies that a software for tracking modification is used).

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Regarding claim 3, which is dependent on claim 1, Manning discloses utilizing a data translation operation (col 4, lines 52-67: converting documents to a different font using conversion program).

Regarding claim 4, which is dependent on claim 1, Manning and Keskar disclose that said disconnected device comprises a PDA (Manning: col 3, lines 1-14; Keskar: col 4, lines 55-67).

Regarding claim 5, which is dependent on claim 1, Manning does not disclose determining whether to integrate said modification into said original document.

Keskar discloses determining whether to integrate said modification into said original document (**col 3, lines 26-55**: determining the relationship between items to be synchronized and items not to be synchronized implies determining whether to integrate the modification into said original document since the new item that makes a document to be modified are items needs to be synchronized and the other items are items need not to be synchronized).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Keskar into Manning since Keskar discloses determining whether to integrate the modification into the original document providing the advantage to incorporate into Manning for effectively integrating the modification into the original document with a proper determination.

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Regarding claim 6, which is dependent on claim 1, Manning does not disclose merging said original document and said modified document.

Keskar discloses merging said original document and said modified document (**col 7, lines 19-55**: the fact that the person relation agent “searches through the ‘document’ and encounters newly created items implies that the modified document, which is the newly created item, is merged into the original document).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Keskar into Manning since Keskar discloses merging the original document and the modified document providing the advantage to incorporate into Manning for obtaining the new version of a document at a desktop computer after being modified in part remotely from a portable device.

Regarding claim 7, which is dependent on claim 1, Manning discloses said original document was created using an office productivity application (col 1, line 66 to col 2, line 11).

Regarding claim 8, which is dependent on claim 1, Manning discloses said document was modified using a companion application (col 4, lines 53-67: using the conversion program to modify the document).

Claims 9-12, 13-16 are for a change tracker of method claims 1-4, 5-8, and are rejected under the same rationale.

Claims 17-20, 21-24 are for a computer program product of method claims 1-4, 5-8, and are rejected under the same rationale.

### ***Response to Arguments***

7. Applicant's arguments filed 7/23/04 have been fully considered but they are not persuasive.

Applicants argue that Sragner does not teach or suggest a "disconnected device" as amended (Remarks, page 6).

Examiner agrees.

Manning and Keskar disclose the argued feature. See the rejection above.

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### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eldridge et al. (US Pat No. 6,430,601 B1, 8/6/02, filed 3/16/99).

Young et al. (US Pat No. 5,325,046, 6/28/94).

Mak et al. (US Pat App Pub No.2004/0205539 A1, 10/14/04, filed 9/7/01).

Proulx et al. (US Pat App Pub No.2002/0124019 A1, 9/5/02, filed 1/3/01).

Bergman et al. (US Pat App Pub No.2002/0087603 A1, 7/4/02, filed 1/2/01).

Janiak et al. (US Pat App Pub No.2002/0089410 A1, 7/11/02, filed 5/11/01, priority 11/13/00).



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Allam et al. (US Pat App Pub No.2002/0116420 A1, 8/22/02, filed 12/15/00, priority 9/28/00).

Kernahan (US Pat App Pub No.2002/0128903 A1, 9/12/02, filed 8/23/99).

Duncombe et al. (US Pat App Pub No.2003/0120685 A1, 6/26/03, filed 11/6/02, priority 11/6/01).

Liu (US Pat App Pub No.2002/0065939 A1, 5/30/02, filed 11/30/00).

Cohen et al. (US Pat App Pub No.2004/0205046 A1, 10/14/04, filed 11/29/01).

Myers et al., Collaboration Using Multiple PDAs Connected to a PC, ACM 1998, pages 285-294.

Buyukkokten et al., Power Browser : Efficient Web Browsing for PDAs, ACM 2000, pages 430-437.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh  
Examiner  
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07/7/05